

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK AND APPEAL BOARD

IN THE MATTER OF TRADEMARK REGISTRATION NO. 2,372,585
Registered August 1, 2000

BOYDS COLLECTION, LTD.,)	Cancellation No. 32,146
Petitioner,)	
)	
v.)	<u>Mark:</u> TBC HERRINGTON'S TEDDY
)	BEAR CLUB & Design
HERRINGTON & COMPANY, INC.,)	<u>Registration No.:</u> 2,372,585
Registrant.)	<u>Registration Date:</u> August 1, 2000

REGISTRANT'S RESPONSE TO PETITIONER'S MOTION TO SUSPEND

In response to Petitioner BOYDS COLLECTION, LTD. ("Petitioner")'s Motion to Suspend the above captioned action, Registrant HERRINGTON & COMPANY, INC. ("Registrant") hereby responds to the Motion to Suspend. Registrant requests that the Board consider this response under TBMP § 510, 37 C.F.R. § 2.117.

It is well known that the suspension of a Board proceeding pending the final determination of another proceeding is solely within the discretion of the Board. TBMP § 510. Registrant hereby opposes Petitioner's Motion to Suspend and requests that the Board, in its discretion, deny the Motion to Suspend on the grounds that there was pending at the time Petitioner's Motion to Suspend was filed, a motion that is potentially dispositive of the above cancellation action and that the civil action filed by Petitioner does not involve issues that are directly in common with those in the instant cancellation action. See TBMP § 510.02 (citing to 37 C.F.R. § 2.117(b) and Notice of Final Rulemaking published in the *Federal Register* on May 23, 1983 at 48 FR 23122, 23129).

On September 10, 2002, Registrant filed a Motion to Strike Petitioner's Notice of Reliance in the above action. On September 27, 2002 Petitioner filed a response to said motion and on October 10, 2002 Registrant filed a reply thereto. This Motion to Strike is currently pending before the Board and was pending when the instant Motion to Suspend was filed by Petitioner. The decision on the Motion to Strike is potentially dispositive of the action as a whole.

It is the policy of the Board to prevent a petitioner who was served with a potentially dispositive motion from escaping that motion by filing a civil action and then moving to suspend before the Board has decided the potentially dispositive motion. See TBMP § 510.02(a). This is exactly what Petitioner is attempting to do in this case.

Therefore, under TBMP § 510.02(a) and 37 C.F.R. § 2.117(b), Registrant respectfully requests that the Board first decide the potentially dispositive motion before the question of suspension is considered.

Additionally, because the civil action recently filed by Petitioner does not deal with the same issues involved in the instant proceeding, we request that the Board exercise its discretion and deny Petitioner's Motion to Suspend.

Dated: December 30, 2002

Respectfully submitted,
HERRINGTON & COMPANY, INC.

By: P. Craig Cardon
P. Craig Cardon
Elizabeth Moreno McArthur
SQUIRE SANDERS & DEMPSEY L.L.P.
1 Maritime Plaza, Suite 300
San Francisco, CA 94111
Tel: (415)-954-0200
Attorneys for Registrant

Express Mail mailing label No. EL 952564537 US

Date of Deposit January 3, 2003

I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.110 on the date indicated above and is addressed to: Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513.

Sadie Lum

(Type or Print Name of Person Mailing Paper or Fee)

Sadie Lum

(Signature of Person Mailing Paper or Fee)

P. Craig Cardon, Esq.
Squire, Sanders & Dempsey L.L.P.
One Maritime Plaza
Suite 300
San Francisco, CA 94111
(415) 954-0200

Attorneys for Registrant

SanFrancisco/65359.1

Reg. No. 2,372,585

File No. 40362.6

By E. McArthur

Mark: TBC HERRINGTON'S TEDDY BEAR CLUB & Design

Date Mailed January 3, 2003 Due Date

The following has been received in the U.S. Patent and Trademark Office on the date stamped hereon:
Registrant's Response to Petitioner's Motion to Suspend

- Trademark Application/Specimens
- ITU Trademark Application
- Formal Drawing
- Declaration under Section 2.20
- Affidavit/Declaration
- Substitute Specimens
- Extension of Time Request # _____ for SOU
- Statement of Use/Amendment to Allege Use
- Amendment/Response
- Exhibit _____
- Power of Attorney
- Appointment of Domestic Representative
- Assignment & Cover Sheet
- Security Interest Assignment & Cover Sheet
- Petition to Revive
- Request for Reconsideration
- Notice of Appeal
- Appeal Brief
- Combined Section 8 & 15 Declaration
- Trademark Renewal Application
- Extension of Time to Oppose-Request # _____
- Notice of Opposition
- Answer to Opposition
- Transmittal Letter/Pastcard
- Express Mail Certificate
- Deposit Account Authorization
- Other _____

SQUIRE, SANDERS & DEMPSEY L.L.P.

One Maritime Plaza, Suite 300
San Francisco, California 94111-3492

Office: +1.415.954.0200
Fax: +1.415.393.9887

Direct Dial: +1.415.954.0298
ccardon@ssd.com

SQUIRE SANDERS | LEGAL
COUNSEL
WORLDWIDE

December 30, 2002

BY U.S. EXPRESS MAIL

United States Patent and Trademark Office
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513
Attention: Legal Assistant, TTAB

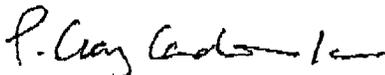
Re: Cancellation No.: 32,282
Mark: TBC HERRINGTON'S TEDDY BEAR CLUB & Design
Registration No.: 2,382,866
Registration Date: September 5, 2000
Registrant: Herrington & Company, Inc.
Our Ref.: 40362.10

Dear Sir or Madam:

Enclosed herewith is Registrant's Response to Petitioner's Motion to Suspend for the above referenced matter. So that we may have a timely record of receipt of the enclosed, please date-stamp the enclosed, stamped, self-addressed post card, and deposit it into the U.S. mail.

Please direct all correspondence regarding this matter to my attention.

Very truly yours,



P. Craig Cardon
Attorney at Law

PCC/sl

Enclosure

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK AND APPEAL BOARD**

IN THE MATTER OF TRADEMARK REGISTRATION NO. 2,382,866
Registered September 5, 2000

BOYDS COLLECTION, LTD.,)	Cancellation No. 32,282
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)	
v.)	Mark: TBC HERRINGTON'S TEDDY
)	BEAR CLUB & Design
HERRINGTON & COMPANY, INC.,)	Registration No.: 2,382,866
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On October 7, 2002, Registrant filed a Motion to Strike and Objections to Petitioner's Notice of Reliance in the above action. On October 25, 2002 Petitioner filed a response to said motion and on November 14, 2002 Registrant filed a reply thereto. This Motion to Strike is currently pending before the Board and was pending when the instant Motion to Suspend was filed by Petitioner. The decision on the Motion to Strike is potentially dispositive of the action as a whole.

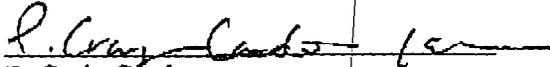
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Dated: December 30, 2002

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1 Maritime Plaza, Suite 300
San Francisco, CA 94111
Tel: (415) 954-0200
Attorneys for Registrant

Express Mail mailing label No. EL 952564523 US

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Sadie Lum
(Type or Print Name of Person Mailing Paper or Fee)

Sadie Lum
(Signature of Person Mailing Paper or Fee)

P. Craig Cardon, Esq.
Squire, Sanders & Dempsey L.L.P.
One Maritime Plaza
Suite 300
San Francisco, CA 94111
(415) 954-0200

Attorneys for Registrant

Reg. No. 2,382,866 File No. 40362-10 By E. McArthur

Mark: TBC HERRINGTON'S TEDDY BEAR CLUB & Design

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Statement of Use/Amendment to Allege Use
Amendment/Response
Exhibit
Power of Attorney
Appointment of Domestic Representative
Assignment & Cover Sheet
Security Interest Assignment & Cover Sheet
Petition to Revive
Request for Reconsideration
Notice of Appeal
Appeal Brief
Combined Section 8 & 15 Declaration
Trademark Renewal Application
Extension of Time to Oppose Request #
Notice of Opposition
Answer to Opposition
Transmittal Letter/Postcard
Express Mail Certificate
Deposit Account Authorization
Other



SQUIRE, SANDERS & DEMPSEY L.L.P.

One Maritime Plaza, Suite 300
San Francisco, California 94111-3492

Office: +1.415.954.0200
Fax: +1.415.393.9887

Direct Dial: +1.415.954.0298
ccardon@ssd.com

December 30, 2002

BY U.S. EXPRESS MAIL

United States Patent and Trademark Office
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513
Attention: Legal Assistant, TTAB

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Attorney at Law

PCC/sl

Enclosure

SQUIRE SANDERS

LEGAL
COUNSEL
WORLDWIDE

SQUIRE, SANDERS & DEMPSEY L.L.P.

One Maritime Plaza, Suite 300
San Francisco, California 94111-3492

Office: +1.415.954.0200
Fax: +1.415.393.9887
Preferred Fax: +1.415.393.9887
If Problems: +1.415.954.0303

January 3, 2003

PLEASE DELIVER THESE PAGES IMMEDIATELY

No. of Pages (including cover): 11

To: David M. Mermelstein

Facsimile No: 703.746.7083

Company:

Confirmation No:

From: Elizabeth Moreno McArthur

Direct Dial No: +1.415.954.0287

E-mail: emcarthur@ssd.com

Re: TBC HERRINGTON'S TEDDY BEAR CLUB & Design
Our Ref.: 40362.06 and .10

Message: Pursuant to our discussion, please see attached.

CONFIDENTIALITY NOTICE:

The attached information is LEGALLY PRIVILEGED AND CONFIDENTIAL and is intended only for the use of the addressee named above. If the reader of this message is not the intended recipient or the employee or agent responsible for delivering the message to the intended recipient, please be aware that any dissemination, distribution or duplication of this communication is strictly prohibited. If you have received this communication in error, please notify us immediately by telephone and return the original message to us at the address above via the postal service. Thank you.

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